



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,081	09/09/2004	Nicholas John Newcombe	056291-5178	2669
9629 7590 03/03/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
RAO, DEEPAK R				
ART UNIT		PAPER NUMBER		
1624				
MAIL DATE		DELIVERY MODE		
03/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/507,081

**Applicant(s)**

NEWCOMBE ET AL.

**Examiner**

Deepak Rao

**Art Unit**

1624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 21, 33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21, 33 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 20071119 & 20080130
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to the amendment filed on November 19, 2007.

Claims 1-17, 21, 33 and 35 are pending in this application.

#### ***Withdrawn Rejections/Objections:***

Applicant is notified that any outstanding rejection/objection that is not expressly maintained in this office action has been withdrawn or rendered moot in view of applicant's amendments and/or remarks.

The terminal disclaimer filed on January 10, 2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,969,714 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***The following rejections are maintained:***

1. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of treating rheumatoid arthritis, does not reasonably provide enablement for a method for producing a cell cycle inhibitory (anti-cell proliferation) effect. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The reasons provided in the previous office action are incorporated here by reference.

Applicant's arguments have been fully considered but they were not deemed to be persuasive. Applicant argues that 'the method finds enablement in WO 02/04429 based on the SRB assay discussed therein'. However, the experimental procedure described in the reference

(WO 02/04429 or US 6,908,920) is related to the biological activity with respect to specific type of cancer (specifically retinoblastoma). The instant specification and the reference indicate that 'anti-cell-proliferation effect relates to anti-cancer activity'. There is nothing in the specification how the reference assay data for a single type of cancer, extrapolates to all the other types of proliferative diseases encompassed by the instant claims. Applicant did not state on record or provide any guidance that the assays provided are correlated to the clinical efficacy of the treatment of various disorders encompassed by the claims. As can be seen from specification, the *in vitro* data holds significant role in determining the dosage regimen based on the minimal effective concentration of each of the compound to achieve the desired inhibition of the enzymes. Contrary to applicant's arguments, the state of the art does not establish that a single therapeutic approach exists for the treatment of the types of cancers and/or leukaemias. The development of the most efficacious strategy for the treatment of cancers is based on understanding the underlying mechanisms of carcinogenesis. This includes the knowledge that the carcinogenic process is a multi-step, multi-mechanism process and that no two cancers are alike, in spite of some apparent universal characteristics, such as their inability to have growth control, to terminally differentiate, to apoptose abnormally and to have an apparent extended or immortalized life span. Since tumor promotion phase involves multiple mechanisms, there is no existence of a single therapeutic approach. The evidence of record does not disclose any known compounds of similar structure, which have been demonstrated to treat all cancers.

2. Claims 1-17, 21, 33 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11 and 22-25 of copending Application No. 10/507,163.
3. Claims 1-17, 21, 33 and 35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 and 21-24 of copending Application No. 10/507,169.

The reasons provided in the previous office action with respect to each of the references above are incorporated here by reference. It is acknowledged that applicants will address the above rejections when the claims are in condition for allowance. The rejections are maintained as there still issues remaining in this application.

Receipt is acknowledged of the Information Disclosure Statements filed on November 19, 2007 and January 30, 2008 and copies are enclosed herewith.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Monday-Friday from 8:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/Deepak Rao/  
Primary Examiner  
Art Unit 1624**

March 3, 2008